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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,887	11/14/2003	Werner Knebel	5005.1064	1103
23280	7590	05/02/2005		
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			EXAMINER PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,887

Applicant(s)

KNEBEL ET AL.

Examiner

Joshua L. Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed March 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The David Piston "Time-resolved fluorescence imaging and background rejection by two-photon excitation in laser scanning microscopy" reference was not included in the IDS. It has been placed in the application file, but the "Time-resolved fluorescence imaging and background rejection by two-photon excitation in laser scanning microscopy" has not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hakamata (US 5,065,008).

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Regarding claim 1, Hakamata discloses a scanning microscope having a detector (25), arranged in a detection beam path (Fig. 1), for receiving detection light proceeding from a sample (20) and an optical shutter (23) means between the sample and the detector with which the detection beam path can be blocked (col. 7 lines 54-67).

Regarding claim 3, Hakamata discloses a descanned detector (Fig. 1).

Regarding claim 4, Hakamata discloses a control means for controlling the shutter means (col. 8 lines 31-39).

Regarding claim 5, Hakamata discloses the detection beam path can be automatically opened up before the beginning of a scanning operation and blocked at the end of a scanning operation (col. 8 lines 31-39).

Regarding claims 6-8, Hakamata discloses the detection beam path is automatically blockable when the light power level of the detection light exceeds a definable threshold (col. 8 lines 31-39), a means for monitoring the light power level of the detection light and extrapolates future change over the time in the detection light power level (col. 8 line 61 – col. 9 line 7). Hakamata states that when the light is not directed to a certain location on the shutter means, thus the light power level exceeds a minimum threshold; the shutter is closed at that location. Hakamata further states that as the scanning progresses the shutter can get out of sync with the scanning process and can then be adjusted, thus anticipating changes in the power level with relation to the shutter means over time.

Regarding claim 9, Hakamata discloses the shutter means contains an LCD element (col. 7 lines 54-56).

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Regarding claim 10, Hakamata discloses the detector contains a photomultiplier (col. 7 lines 54-56).

Regarding claim 11, Hakamata discloses the scanning microscope is a confocal scanning microscope (col. 7 lines 10-13).

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hanninen (US 5,523,573).

Hanninen discloses a microscope having a detector (CCD) arranged in a detection beam path (Fig. 5) for receiving detecting light proceeding from a sample (N1) and an optical shutter (S1) means between the sample and the detector for which the detection beam path can be blocked (Fig. 5). Hanninen further discloses the detector is a non-descan detector (Fig. 5).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318.

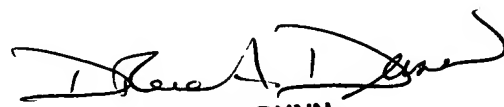
The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP *JP*


DREW A. DUNN
SUPERVISORY PATENT EXAMINER